

REMARKS

Claims 1-13 and 25-33 are pending in the application. Claims 1-11 and 25 through 33 have been allowed.

Claims 12 and 13 are rejected under 35 U.S.C. §112, first paragraph, because the Examiner states that the specification, while being enabling for providing holding contact only with side surfaces of the microcomponent or microstructured molded part, does not reasonably provide enablement for providing holding contact with both side surfaces and with other surfaces which actually contain microstructures. The Examiner cites the fourth paragraph of page 6 of the specification which indicates that "the invented holding contact exists only with the side surfaces of the microcomponent...". The Examiner states, therefore that the use of "holding contact of at least parts of the side surfaces of the microstructured molded part" is not commensurate in scope with what Applicants state is their invented holding contact.

It is respectfully submitted that the limitation previously added to independent claim 12, namely, "wherein the prefabricated magazine carries the at least one microstructured molded part by holding contact of at least parts of the side surfaces of the microstructured molded part" is adequately described within the specification and would enable those skilled in the art to make and use the invention. A fairly uniform standard for determining compliance with the written description requirement has been maintained throughout the years. For example, the Federal Circuit in *Ralston Purina Co. v. Far-Mor-Co, Inc.*, 772 F.2d 1570, 227 USPQ 177 (Fed. Cir. 1985), stated that the "the test for sufficiency of support in a parent application is whether the disclosure of the application relied upon 'reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter'". In *Staehelin v. Secher*, the Board added that "[s]atisfaction of the 'written description' requirement does not require in haec verba antecedence in the originally filed application", 24 USPQ 2d 1513 (B.P.A.I. 1992). Further, in *Ex parte Parks*, 30 USPQ 2d 1234 (B.P.A.I. 1994), the Board further elaborated:

"Adequate description under the first paragraph of 35 U.S.C. 112 does not require literal support for the claimed invention . . . Rather, it is sufficient if the originally-filed disclosure would have conveyed to one

having ordinary skill in the art that an appellant had possession of the concept of what is claimed."

It is respectfully submitted that the fourth paragraph of page 6 relied upon by the Examiner relates to only one of numerous embodiments and descriptions of the invention set forth in the specification as filed.

The claim limitation "wherein the prefabricated magazine carries the at least one microstructured molded part by holding contact of at least parts of the side surfaces of the microstructured molded part" is supported in the specification as originally filed on at least page 10, second and third paragraphs, and in FIGS. 8, 11a & b and 12a & b, and the corresponding description of the figures.

Page 10, second paragraph clearly states that "the invented magazine can hold the microcomponents in a flexible way at any physical height and either on the lateral and/or facing surfaces and/or bottom surfaces". It is further stated that "the holding contact may be positive across the entirety of the respective surface or merely at parts of the respective surface." Page 10, third paragraph, states that the holding contact between the magazine and one or several areas of the microcomponent surface are formed in a way where the magazine's mold material does not create a chemical connection to the molded part's mold material but rather in the form of a physical holding contact, so that very little force is needed to detach the microcomponent from the magazine. In such a manner, the microcomponents can also be pressed out of the magazine by hand or machine.

Figure 8 clearly shows the claimed limitation as magazine 12 carries at least one microstructured molded part by holding contact of the side surfaces as well as an additional surface, i.e. a face surface of the microstructured molded part. Likewise, Figures 11a and 11b show another design example wherein the magazine carries the at least one microstructured molded part for holding contact of at least parts of the side surfaces as well as another surface, a bottom surface 34. Thus, it is respectfully submitted that the 35 U.S.C. §112, first paragraph, rejection is improper.

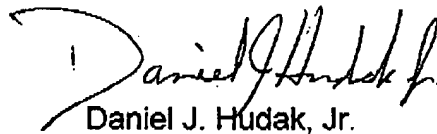
The Examiner states that page 6, fourth paragraph, also implies the desire to avoid holding contact with surfaces that may actually contain microstructures. The

sentence "This generally provides protection for the microstructures of the microcomponents, since the holding contact between magazine and microcomponent can be created on side surfaces that do not contain any microstructures." In the German priority document the word "auch" which is translated as "also" is included. Accordingly, the above noted sentence should be taken to express that the holding contact between magazine and microcomponent also can be created on side surfaces without microstructures as well as side surfaces with microstructures. Accordingly, paragraph 4 of page 6 does not imply a desire to avoid holding contact with surfaces that may actually contain microstructures as suggested by the Examiner.

It is respectfully submitted that the claims are in condition for allowance and a notice of such is earnestly solicited. Should the Examiner have any questions regarding this response, a telephone call to the undersigned is greatly appreciated in order to expedite allowance of the application.

Respectfully submitted,

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